

1 SULLIVAN, HILL, LEWIN, REZ & ENGEL  
 A Professional Law Corporation  
 2 Jeffrey D. Lewin, SBN 68202  
 550 West "C" Street, Suite 1500  
 3 San Diego, California 92101  
 Telephone: (619) 233-4100  
 4 Fax Number: (619) 231-4372

5 Attorneys for METABO CORPORATION

6

7

8

UNITED STATES DISTRICT COURT

9

SOUTHERN DISTRICT OF CALIFORNIA

10 JENS ERIK SORENSEN, as Trustee of  
 SORENSEN RESEARCH AND  
 11 DEVELOPMENT TRUST,

12 Plaintiff,

13 v.

14 METABO CORPORATION, a Delaware  
 Corporation; METABOWERKE GMBH  
 15 A German Corporation; and DOES 1-100,

16 Defendants.

17

18

Case No. 08-cv-0304 BTM CAB

**DECLARATION OF JEFFREY  
 LEWIN IN SUPPORT OF  
 DEFENDANT'S MOTION TO STAY  
 THE LITIGATION PENDING  
 REEXAMINATION OF U.S.  
 PATENT NO. 4,935,184**

Date: June 20, 2008

Time: 11:00 a.m.

Courtroom: 15

Hon. Barry Ted Moskowitz

NO ORAL ARGUMENT UNLESS  
 REQUESTED BY THE COURT

19 I, Jeffrey Lewin, hereby declare as follows:

20 I am a shareholder at the law firm of Sullivan Hill Lewin Rez & Engel, attorneys of record  
 21 for Metabo Corporation ("Metabo"). I am licensed to practice law in the State of California and am  
 22 admitted to appear before this Court. The matters contained in this declaration are of my personal  
 23 knowledge.

24 1. Attached as Exhibit A is a true and correct copy of the Order Granting *Ex Parte*  
 25 Reexamination mailed October 11, 2007.

26 2. Attached as Exhibit B is a true and correct copy of the Order Granting *Ex Parte*  
 27 Reexamination mailed February 21, 2008.

28

3. Attached as Exhibit C is a true and correct copy of the Court's order granting defendant's Motion to Stay a related case, Sorensen v. Black & Decker Corp., No. 06cv1572, (S.D. Cal. Sept. 10, 2007).

4. Attached as Exhibit D is a true and correct copy of the Court's order granting defendant's Motion to Stay a related case, Sorensen v. Giant International, No. 07cv2121, (S.D. Cal. February 28, 2008).

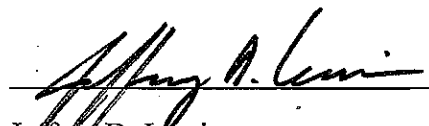
5. Attached as Exhibit E is a true and correct copy of the Court's order granting defendant's Motion to Stay a related case, Sorensen v. Esseplast (USA) NC, Inc. No. 07cv2277 (S.D. Cal. March 19, 2008).

6. Attached as Exhibit F is a true and correct copy of the Court's order granting defendant's Motion to Stay a related case, Sorensen v. Energizer Holdings Inc., No. 07cv2321 (S.D. Cal. March 19, 2008),

7. Attached as Exhibit G is a true and correct copy of the Court's order granting defendant's Motion to Stay a related case Sorensen v. Helen of Troy 07cv2278 (S.D. Cal. February 28, 2008).

8. On April 7, 2008, Melody A. Kramer informed me that she opposes this motion.

I declare under penalty of perjury that the foregoing is true and correct. Executed this 7th day of April, 2008 in San Diego, CA.

  
Jeffrey D. Lewin

**EXHIBIT A**



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,775	07/30/2007	4935184	X32441	9943

22653 7590 10/11/2007

EDWARD W CALLAN  
 NO. 705 PMB 452  
 3830 VALLEY CENTRE DRIVE  
 SAN DIEGO, CA 92130

EXAMINER
----------

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED: 10/11/2007

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

10/11/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Arnold Turk, Esq.  
Greenblum & Bernstein P. L. C.  
1950 Roland Clarke Place  
Reston VA 20191

***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO 90/008775

PATENT NO. 4,935,184

ART UNIT-3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	90/008,775	4935184	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alan Diamond	3991	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 30 July 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: \_\_\_\_\_

1. ☒ The request for *ex parte* reexamination is GRANTED.

**RESPONSE TIMES ARE SET AS FOLLOWS:**

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the date of service of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a) ☐ by Treasury check or,  
b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or  
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Alan Diamond  
Primary Examiner  
Art Unit: 3991

cc:Requester ( if third party requester )

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 2

### ***Decision on Reexamination Request***

1. A substantial new question of patentability affecting claims 1, 2, 4, and 6-10 of United States Patent Number 4,935,184 to Sorensen, is raised by the request for *ex parte* reexamination. The request for reexamination is Third Party requested.

2. Since requestor did not request reexamination of claims 3 and 5 and did not assert the existence of a substantial new question of patentability (SNQ) for such claims (see 35 U.S.C. § 302); see also 37 CFR 1.510b and 1.515), such claims will not be reexamined. This matter was squarely addressed in *Sony Computer Entertainment America Inc., et al v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. The District Court upheld the Office's discretion to not reexamine claims in a reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

"To be sure, a party may seek, and the PTO may grant, ...review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which ... review was not requested, nothing in the statute compels it to do so. To ensure that the PTO considers a claim for ... review, ...requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that **Sony** did not seek review of every claim under the '213 and '333 patents. Accordingly, **Sony** cannot now claim that the PTO wrongly failed to reexamine claims for which **Sony** never requested review, and its argument that AIPA compels a contrary result is unpersuasive."

### ***Extension of Time***

3. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 3

*ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

***Substantial New Question of Patentability (SNQ)***

4. The presence or absence of a "substantial new question of patentability" determines whether or not reexamination is ordered.

For a "substantial new question of patentability" to be present, it is only necessary that :

A) the prior art patents and/or printed publications raise a substantial new question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and

B) the same question of patentability as to the claim has not been decided by the Office in a previous examination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

A SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation in the request. (MPEP 2242).



Application/Control Number: 90/008,775  
Art Unit: 3991

Page 4

***Request***

**5. The request indicates the Requestor considers that Moscicki (U.S. Patent 3,178,497) raises a substantial new question of patentability with respect to claims 1, 4, 6-8 and 10 of Sorensen.**

It is agreed that consideration of Moscicki raises a substantial new question of patentability as to claims 1, 4, 6-8 and 10 of Sorensen. Page 28, line 14 through page 32, seventh line from the bottom; page 56 at the start of section 8 through page 58, line 5; page 83, line 13 through page 86, line 9; page 86, line 22 through page 87, line 22; page 94, lines 1-19; page 98, line 6 through page 99, line 2; and page 107, line 18 through page 108, line 11, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Moscicki that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1, 4, 6-8 and 10 of Sorensen were patentable. Accordingly, Moscicki raises a substantial new question of patentability as to claims 1, 4, 6-8 and 10, which question has not been decided in a previous examination of the Sorensen patent.

**6. The request indicates the Requestor considers that Seima (GB 2004494 A) raises a substantial new question of patentability with respect to claims 1, 2 and 6-10 of Sorensen.**

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 5

It is agreed that consideration of Seima raises a substantial new question of patentability as to claims 1, 2 and 6-10 of Sorensen. Page 32, sixth line from the bottom, through the end of page 36; page 60, fifth line from the bottom, through page 62, line 3; page 80, line 10 through page 83, line 12; page 88, line 13 through page 89, line 15; page 95, line 13 through page 96, line 9; page 99, line 15 through page 100, line 11; page 104, line 1 through page 107, line 4; and page 109, lines 1-20, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Seima that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1, 2 and 6-10 of Sorensen were patentable. Accordingly, Seima raises a substantial new question of patentability as to claims 1, 2 and 6-10, which question has not been decided in a previous examination of the Sorensen patent.

**7. The request indicates the Requestor considers that Gits (U.S. Patent 2,863,241) raises a substantial new question of patentability with respect to claim 1 of Sorensen.**

It is agreed that consideration of Gits raises a substantial new question of patentability as to claim 1 of Sorensen. Page 37, line 1 through the end of section 3 on page 40, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Gits that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 6

that a reasonable examiner would consider this teaching important in deciding whether or not claim 1 of Sorensen was patentable. Accordingly, Gits raises a substantial new question of patentability as to claim 1, which question has not been decided in a previous examination of the Sorensen patent.

**8. The request indicates the Requestor considers that Shiho *et al* (U.S. Patent 4,440,820, hereinafter "Shiho") raises a substantial new question of patentability with respect to claims 1, 6-8 and 10 of Sorensen.**

It is agreed that consideration of Shiho raises a substantial new question of patentability as to claims 1, 6-8 and 10 of Sorensen. The beginning of section 4 on page 40 through the end of section 4 on page 44; page 90, lines 4-20; page 96, line 23 through page 97, line 6; page 101, lines 1-11; and page 110, lines 14-23, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Shiho that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1, 6-8 and 10 of Sorensen were patentable. Accordingly, Shiho raises a substantial new question of patentability as to claims 1, 6-8 and 10, which question has not been decided in a previous examination of the Sorensen patent.

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 7

**9. The request indicates the Requestor considers that JP 60-119520 U to Toyota Motor (hereinafter "Toyota") raises a substantial new question of patentability with respect to claim 1 of Sorensen.**

It is agreed that consideration of Toyota raises a substantial new question of patentability as to claim 1 of Sorensen. The beginning of section 5 on page 44 through the end of section 5 on page 48; and page 70, line 1 through page 71, line 8, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Toyota that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 1 of Sorensen was patentable. Accordingly, Toyota raises a substantial new question of patentability as to claim 1, which question has not been decided in a previous examination of the Sorensen patent.

**10. The request indicates the Requestor considers that German Published Patent Application No. 1850999 to Echterholter raises a substantial new question of patentability with respect to claim 1 of Sorensen.**

It is agreed that consideration of Echterholter raises a substantial new question of patentability as to claim 1 of Sorensen. The beginning of section 6 on page 48 through page 53, line 6; and page 73, line 10 through page 74, line 17, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Echterholter that was not present in the prosecution of the

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 8

application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 1 of Sorensen was patentable. Accordingly, Echterholter raises a substantial new question of patentability as to claim 1, which question has not been decided in a previous examination of the Sorensen patent.

**11. The request indicates the Requestor considers that Wright, "New vigor for two-shot molding automation... versatility... ingenuity," Modern Plastics, May 1986, pp. 79-83, (hereinafter "Modern Plastics") raises a substantial new question of patentability with respect to claims 1, 6 and 8 of Sorensen.**

It is agreed that consideration of Modern Plastics raises a substantial new question of patentability as to claims 1, 6 and 8 of Sorensen. Page 53, line 7 through the end of section 7 on page 56; page 77, line 1 through page 78, line 8; page 92, line 9 through page 93, line 12; and page 102, line 16 through page 103, line 11, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Modern Plastics that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1, 6 and 8 of Sorensen were patentable. Accordingly, Modern Plastics raises a substantial new question of patentability as to claims 1, 6 and 8, which question has not been decided in a previous examination of the Sorensen patent.

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 9

**12. The request indicates the Requestor considers that Moscicki in view of Echtherholter and further in view of Modern Plastics raises a substantial new question of patentability with respect to claims 1, 4, 6-8 and 10 of Sorensen.**

It is agreed that consideration of Moscicki in view of Echtherholter and further in view of Modern Plastics raises a substantial new question of patentability as to claims 1, 4, 6-8 and 10 of Sorensen. Page 58, line 6 through the end of section 9 on page 60; page 86, lines 10-21; page 88, lines 1-12; page 95, lines 1-12; page 99, lines 3-14; and page 108, lines 12-23, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Moscicki, Echtherholter and Modern Plastics that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1, 4, 6-8 and 10 of Sorensen were patentable. Accordingly, Moscicki in view of Echtherholter and further in view of Modern Plastics raises a substantial new question of patentability as to claims 1, 4, 6-8 and 10, which question has not been decided in a previous examination of the Sorensen patent.

**13. The request indicates the Requestor considers that Seima in view of Echtherholter and further in view of Modern Plastics raises a substantial new question of patentability with respect to claims 1 and 6-10 of Sorensen.**

It is agreed that consideration of Seima in view of Echtherholter and further in view of Modern Plastics raises a substantial new question of patentability as to claims 1 and

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 10

6-10 of Sorensen. Page 62, line 4 through page 64, line 3; page 89, line 16 through page 90, line 3; page 96, lines 10-22; page 100, lines 12-24; page 107, lines 5-17; and page 110, lines 1-13, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Seima, Echterholter and Modern Plastics that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 6-10 of Sorensen were patentable. Accordingly, Seima in view of Echterholter and further in view of Modern Plastics raises a substantial new question of patentability as to claims 1 and 6-10, which question has not been decided in a previous examination of the Sorensen patent.

**14. At page 64, line 4 through page 67, line 18; page 90, line 21 through page 91, line 13; page 97, lines 7-16; and page 101, lines 12-22, the request indicates the Requestor considers that Schad (U.S. Patent 4,422,995) raises a substantial new question of patentability with respect to claims 1 and 6-8 of Sorensen.**

Schad **does not** raise a substantial new question of patentability with respect to claims 1 and 6-8 of Sorensen. In the prosecution of application Serial No. 07/386,012, which matured into the Sorensen patent, Schad was used to reject all the claims (1-10) under 35 USC 103(a). The rejection over Schad was overcome and the Sorensen patent was allowed after applicant amended steps (h) and (i) of claim 1 so as to recite the injection of first/second plastic material until it reaches the portion of the first/second

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 11

mold cavity that defines the rim of the product. Third party requestor even admits at page 66, lines 16-18, of the request that "Schad does not specifically disclose a first injection material which 'reaches the portion of the mold cavity that defines the rim of the product.'" Third party requestor cites *KSR int'l Co. v. Teleflex Inc.* and design choice for the obviousness of modifying Schad so that a first injection material reaches the portion of the mold cavity that defines the rim of the product (Request, pages 66-67). Third party requestor notes that "design choice" with respect to product shape was considered by the Examiner in the rejection over Schad that was mailed 10/11/1988 during prosecution of the 07/386,012 application (see page 67 of the Request).

Consideration of Shad in view of *KSR int'l Co. v. Teleflex Inc.* or "design choice" does not provide any new teaching with respect to Schad as compared with its use in the prosecution of the Sorensen patent. Accordingly, Schad is not being viewed in a new light compared with its use in the prosecution of the Sorensen patent, and thus, does not raise a substantial new question of patentability with respect to claims 1 and 6-8 of Sorensen.

**15. The request indicates the Requestor considers that Schad in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability with respect to claims 1 and 6-8 of Sorensen.**

It is agreed that consideration of Schad in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability as to claims 1 and 6-8 of Sorensen. Page 67, lines 19 through the last line on page 69; page 91, line 14



Application/Control Number: 90/008,775  
Art Unit: 3991

Page 12

through page 92, line 8; page 97, line 17 through page 98, line 5; and page 102, lines 1-15, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Schad, Moscicki, Seima and Shiho that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 6-8 of Sorensen were patentable. Accordingly, Schad in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability as to claims 1 and 6-8, which question has not been decided in a previous examination of the Sorensen patent.

**16. The request indicates the Requestor considers that Toyota in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability with respect to claim 1 of Sorensen.**

It is agreed that consideration of Toyota in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability as to claim 1 of Sorensen. Page 71, line 9 through page 73, line 9, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Toyota, Moscicki, Seima and Shiho that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 1 Sorensen was patentable. Accordingly, Toyota in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability as to claim

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 13

1, which question has not been decided in a previous examination of the Sorensen patent.

**17. The request indicates the Requestor considers that Echterholter in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability with respect to claim 1 of Sorensen.**

It is agreed that consideration of Echterholter in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability as to claim 1 of Sorensen. Page 74, line 18 through the last line on page 76, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Echterholter, Moscicki, Seima and Shiho that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 1 Sorensen was patentable. Accordingly, Echterholter in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability as to claim 1, which question has not been decided in a previous examination of the Sorensen patent.

**18. The request indicates the Requestor considers that Modern Plastics in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability with respect to claims 1, 6 and 8 of Sorensen.**

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 14

It is agreed that consideration of Modern Plastics in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability as to claims 1, 6 and 8 of Sorensen. Page 78, line 9 through page 80, line 9; page 93, lines 13-25; and page 103, lines 12-24, of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Modern Plastics, Moscicki, Seima and Shiho that was not present in the prosecution of the application which became the Sorensen patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1, 6 and 8 of Sorensen were patentable. Accordingly, Modern Plastics in view of Moscicki and further in view of Seima and Shiho raises a substantial new question of patentability as to claims 1, 6 and 8, which question has not been decided in a previous examination of the Sorensen patent.

#### ***Duty to Disclose***

19. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 4,935,184 throughout the course of this reexamination proceeding. The third party requestor is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Application/Control Number: 90/008,775  
Art Unit: 3991

Page 15

### ***Correspondence***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is (571) 272-1338. The examiner can normally be reached on Monday through Friday from 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

### ***Notice Re Patent Owner's Correspondence Address***

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)*

**The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this**

Application/Control Number: 90/008,775

Page 16

Art Unit: 3991

**revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.**

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Please mail any communications to:

Attn: Mail Stop "Ex Parte Reexam"  
Central Reexamination Unit  
Commissioner for Patents  
P. O. Box 1450  
Alexandria VA 22313-1450

Please FAX any communications to:

(571) 273-9900  
Central Reexamination Unit

Application/Control Number: 90/008,775

Page 17

Art Unit: 3991

Please hand-deliver any communications to:

Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

Signed:

A handwritten signature in black ink, appearing to read "Alan Diamond", written over a horizontal line.

Alan Diamond  
Primary Examiner  
Central Reexamination Unit  
Art Unit 3991  
(571) 272-1338

/Jerry D. Johnson/  
Primary Examiner  
Art Unit 3991

A handwritten signature in black ink, appearing to read "Stephen J. Stein", written in a cursive style.

STEPHEN J. STEIN  
CRU EXAMINER - AU 3991

PTO/SB/08a (05-07)

Approved for use through 09/30/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Not for submission under 37 CFR 1.99)	Application Number	90/008,775
	Filing Date	
	First Named Inventor	
	Art Unit	3991
	Examiner Name	Diamond
	Attorney Docket Number	REQUEST FOR REEXAMINATION

U.S. PATENTS								
Examiner Initial*	Cite No	Patent Number	Kind Code <sup>1</sup>	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
/AD/	1	2863241		1958-12-09	Gits	all		
/AD/	2	3178497		1965-04-13	Moscicki	all		
/AD/	3	4422995		1983-12-27	Schad	all		
/AD/	4	4440820		1984-04-03	Shiho	all		
If you wish to add additional U.S. Patent citation information please click the Add button.								
U.S. PATENT APPLICATION PUBLICATIONS								
Examiner Initial*	Cite No	Publication Number	Kind Code <sup>1</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Published Application citation information please click the Add button.								
FOREIGN PATENT DOCUMENTS								
Examiner Initial*	Cite No	Foreign Document Number <sup>3</sup>	Country Code <sup>2</sup>	Kind Code <sup>4</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T <sup>5</sup>

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Not for submission under 37 CFR 1.99)	Application Number		90/008,775	
	Filing Date			
	First Named Inventor			
	Art Unit		3991	
	Examiner Name		Diamond	
	Attorney Docket Number		REQUEST FOR REEXAMINATION	

/AD/	1	1 850 999	DE		1962-05-03	Echterholter	all	<input checked="" type="checkbox"/>
/AD/	2	2 004 494	GB		1979-04-04	SEIMA	all	<input checked="" type="checkbox"/>
/AD/	3	60-119520 U	JP		1985-08-13	Toyota Motor	all	<input checked="" type="checkbox"/>

If you wish to add additional Foreign Patent Document citation information please click the Add button

#### NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>5</sup>
/AD/	1	VAL WRIGHT, New Vigor For Two-Shot Molding With Automation . . . Versatility . . . Ingenuity, Modern Plastics, May 1968, pages 79-83, published in US	<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

#### EXAMINER SIGNATURE

Examiner Signature	/Alan Diamond/	Date Considered	10/05/2007
--------------------	----------------	-----------------	------------

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> See Kind Codes of USPTO Patent Documents at [www.USPTO.GOV](http://www.USPTO.GOV) or MPEP 901.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.



**EXHIBIT B**



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,976	12/21/2007	4935184	065640-0260	6753

22653 7590 02/21/2008

EDWARD W CALLAN  
 NO. 705 PMB 452  
 3830 VALLEY CENTRE DRIVE  
 SAN DIEGO, CA 92130

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 02/21/2008

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Pavan Agarwal

Foley & Lardner LLP

3000 K Street, NW, Suite 500

Washington, DC 20007

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/008,976.

PATENT NO. 4935184.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	90/008,976	4935184	
	<b>Examiner</b>	<b>Art Unit</b>	
	Krisanne Jastrzab	3991	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 21 December 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: \_\_\_\_\_

1. ☒ The request for *ex parte* reexamination is GRANTED.

**RESPONSE TIMES ARE SET AS FOLLOWS:**

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the date of service of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) ☐ by Treasury check or,  
b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or  
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

/Krisanne Jastrzab/  
Primary Examiner  
Art Unit: 3991

cc:Requester ( if third party requester )

71338 U.S. PTO

PTO/SB/08 (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

12/21/07

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

900009970

Substitute for form 1449/PTO			Complete if Known		
INFORMATION DISCLOSURE STATEMENT BY APPLICANT			Reexamination Control Number	Unassigned	
			Patent Number	4,935,184	
Date Submitted: December 21, 2007			First Named Inventor	Jens O. Sorensen	
Sheet	1	of	2	Attorney Docket Number	065640-0260

## U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
/K.J./	A1	4,935,184	06/19/1990	SORENSEN	
↓	A2	4,422,995	12/27/1983	SCHAD	
	A3	4,508,676	04/02/1985	SORENSEN	
/K.J./	A4	3,375,554	04/02/1968	BLUMER	

## UNPUBLISHED U.S. PATENT APPLICATION DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	U.S. Patent Application Document	Filing Date of Cited Document MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Serial Number-Kind Code <sup>2</sup> (if known)			

## FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Documents	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code*Number*Kind Code <sup>5</sup> (if known)				
/K.J./	A5	JP 59-199227	11/12/1984	IDEMITSU SEKIYU KAGAKU KK		Tr.
↓	A6	JP 60-154022	08/13/1985	FUJITSU, LTD.		Tr.
	A7	JP 58-82401	05/18/1983	NISSAN MOTOR CO., LTD.		Tr.
/K.J./	A8	JP S52-51449	04/25/1977	KABUSHIKI KAISHA YOSHINO KOGYOSHO		Tr.

## NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>6</sup>
	A9	SUMITOMO HEAVY INDUSTRIES, LTD., Premal 100-100/100 Sumitomo Notetal Dual Material Injection Molding Machine	Tr.

Examiner Signature	/Krisanne Jastrzab/	Date Considered	02/20/2008
-----------------------	---------------------	--------------------	------------

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 809. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

WASH\_2164550.1

PTO/SB/08 (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO				<b>Complete If Known</b>	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>				Reexamination Control Number	Unassigned
				Patent Number	4,935,184
Date Submitted: December 21, 2007				First Named Inventor	Jens O. Sorensen
Sheet	2	of	2	Attorney Docket Number	065640-0260

**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>6</sup>
/K.J./	A10	WRIGHT, "New Vigor for Two-Shot Molding with Automation," <i>Modern Plastics</i> , Vol. 45, No. 9, May 1968, pp. 78 - 83.	
	A11	Plaintiffs Amended Preliminary Claim Constructions and Extrinsic Evidence, SORESENSEN v. THE BLACK & DECKER CORPORATION ET AL., U.S. District Court for the Southern District of California, Case No. 06-cv-1572 BTM (CAB).	
	A12	SORESENSEN v. INTERNATIONAL TRADE COM'N., 427 F.3d 1375 (Fed. Cir. 2005)	
	A13	Deposition of Paul P. Brown, December 19, 2006, SORESENSEN v. THE BLACK & DECKER CORPORATION ET AL., U.S. District Court for the Southern District of California, Case No. 06-cv-1572 BTM (CAB).	
/K.J./	A14	Plaintiffs' Local Civil Rule 56.1 Statement of Material Facts in Opposition to Defendants' Motion for Summary Judgment of Invalidity Based on Prior Art, U.S. District Court for the District of New Jersey Newark Vicinage, CIV. No. 03-1763(HAA).	

Examiner Signature	/Krisanne Jastrzab/	Date Considered	02/20/2008
-----------------------	---------------------	--------------------	------------

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 801.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

WASH\_2164550.1

Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 2

### **Reexamination**

#### **Decision on Reexamination Request**

A substantial new question of patentability affecting claims 1, 2, 4 and 6-10 of United States Patent Number 4,935,184 (hereinafter referred to as "the '184 patent") is raised by the request for *ex parte* reexamination. The request was filed by a Third Party on 12/21/2007.

Since requestor did not request reexamination of claims 3 and 5 and did not assert the existence of a substantial new question of patentability (SNQ) for such claims (see 35 U.S.C. § 302); see also 37 CFR 1.510b and 1.515), such claims will not be reexamined. This matter was squarely addressed in *Sony Computer Entertainment America Inc., et al v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. The District Court upheld the Office's discretion to not reexamine claims in a reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

"To be sure, a party may seek, and the PTO may grant .... review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which ... review was not requested, nothing in the statute compels it to do so. To ensure that the PTO considers a claim for ... review, ...requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that Sony did not seek review of every claim under the '213 and '333 patents. Accordingly, Sony cannot now claim that the PTO wrongly failed to reexamine claims for which Sony never requested review, and its argument that AIPA compels a contrary result is unpersuasive."

#### **Extensions of Time**

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that

Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 3

*ex parte* reexamination proceedings "will be conducted with special dispatch" (37

CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

#### **Substantial New Question of Patentability (SNQ)**

The substantial new question of patentability (SNQ) is based on:

JP S59-199227 (hereinafter referred to as "JP '227")

JP 60-154022 (hereinafter referred to as "JP '022")

JP 58-82401 (hereinafter referred to as "JP '401")

JP S52-51449 (hereinafter referred to as "JP '449")

Schad, U.S. patent No. 4,422,995 (hereinafter referred to as "Schad")

Blumer U.S. patent No. 3,375,554 (hereinafter referred to as "Blumer")

Sorensen U.S. patent No. 4,508,676 (hereinafter referred to as "Sorensen")

Promot 100-100/100 (hereinafter referred to as "Promot 100")

Modern Plastics, "New Vigor for Two-Shot Molding with  
Automation...Versatility...Ingenuity" (hereinafter referred to as "Modern Plastics")

A discussion of the specifics follows:

**Request**



Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 4

**The request indicates that the Requestor considers JP '227 as raising a substantial new question of patentability for claims 1, 6-8 and 10 of the '184 patent.**

It is agreed that the consideration of JP '227 raises an SNQ as to claims 1, 6-8 and 10 of the '184 patent. The last paragraph of page 31 through page 42 of the request is hereby incorporated by reference for the explanation of the teachings provided in JP '227 regarding a method of two-shot injection molding of a part utilizing a common mold core. These teachings were not present in the prosecution of the application which became the '184 patent. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable. Accordingly, JP '227 raises a substantial new question of patentability as to claims 1, 6-8 and 10, which question has not been decided in a previous examination of the '184 patent.

**The request indicates that the Requestor considers JP '022 as raising a substantial new question of patentability for claims 1 and 10 of the '184 patent.**

It is agreed that the consideration of JP '022 raises an SNQ as to claims 1 and 10 of the '184 patent. Page 43 through the top of page 47 of the request is hereby incorporated by reference for the explanation of the teachings provided in JP '022 regarding a method of two-shot injection molding of a part utilizing a common mold core. These teachings were not present in the prosecution of the application which became the '184 patent. Further, there is a substantial likelihood that a reasonable

Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 5

examiner would consider these teachings important in deciding whether or not these claims are patentable. Accordingly, JP '022 raises a substantial new question of patentability as to claims 1 and 10, which question has not been decided in a previous examination of the '184 patent.

**The request indicates that the Requestor considers JP '401 as raising a substantial new question of patentability for claims 1 and 10 of the '184 patent.**

It is agreed that the consideration of JP '401 raises an SNQ as to claims 1 and 10 of the '184 patent. The bottom of page 47 through the top of page 52 of the request is hereby incorporated by reference for the explanation of the teachings provided in JP '401 regarding a method of two-shot injection molding of a part utilizing a common mold core. These teachings were not present in the prosecution of the application which became the '184 patent. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable. Accordingly, JP '401 raises a substantial new question of patentability as to claims 1 and 10, which question has not been decided in previous examination of the '184 patent.

**The request indicates that the Requestor considers the combination of JP '449 and the Admitted State of the Prior Art as raising a substantial new question of patentability for claims 1 and 6-9 of the '184 patent.**

Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 6

It is agreed that the combination of JP '449 and the Admitted State of the Prior Art raises an SNQ as to claims 1 and 6-9 of the '184 patent. The bottom of page 6 through the top of page 9, page 22 beginning at "E." through the top of page 27 and page 54 through the top of page 60 of the request is hereby incorporated by reference for the explanation of the Admitted State of the Prior Art and the teachings in JP '449 regarding a method of molding a two-component part. These combined teachings were not present in the prosecution of the application which became the '184 patent. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable. Accordingly, the combination of JP '449 and the Admitted State of the Prior Art, raise a substantial new question of patentability as to claims 1 and 6-9, which question has not been decided in previous examination of the '184 patent.

**The request indicates that the Requestor considers the combination of JP '449, the Admitted State of the Prior Art and Schad as raising a substantial new question of patentability for claim 10 of the '184 patent.**

It is agreed that the combination of JP '449, the Admitted State of the Prior Art and Schad raises an SNQ as to claim 10 of the '184 patent. Page 60 of the request is hereby incorporated by reference for the explanation of the teachings of Schad regarding the separation of mold components in a two-shot molding process as applicable to the combination of the JP '449 and the Admitted State of the Prior Art. These combined teachings were not present in the prosecution of the application which

Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 7

became the '184 patent. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not this claim is patentable. Accordingly, the combination of JP '449, the Admitted State of the Prior Art and Schad, raises a substantial new question of patentability as to claim 10, which question has not been decided in previous examination of the '184 patent.

**The request indicates that the Requestor considers the combination of JP '449 and Modern Plastics as raising a substantial new question of patentability for claim 1 of the '184 patent.**

It is agreed that the combination of JP '449 and Modern Plastics raises an SNQ as to claim 1 of the '184 patent. Pages 60-64 of the request are hereby incorporated by reference for the explanation of the combination of the teachings of JP '449 and Modern Plastic regarding a two-shot molding process. These combined teachings were not present in the prosecution of the application which became the '184 patent. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not this claim is patentable. Accordingly, the combination of JP '449 and Modern Plastics raises a substantial new question of patentability as to claim 1, which question has not been decided in previous examination of the '184 patent.

Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 8

**The request indicates that the Requestor considers the combination of JP '227 and Modern Plastics as raising a substantial new question of patentability for claims 1, 2, 4, and 6-10 of the '184 patent.**

It is agreed that the combination of JP '227 and Modern Plastics raises an SNQ as to claims 1, 2, 4 and 6-10 of the '184 patent. Page 65 through the top of page 68 of the request is hereby incorporated by reference for the explanation of the combination of teachings of JP '227 and Modern Plastics regarding a two-shot molding process. These combined teachings were not present in the prosecution of the application which became the '184 patent. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable. Accordingly, the combination of JP '227 and Modern Plastics raises a substantial new question of patentability as to claims 1, 2, 4 and 6-10, which question has not been decided in previous examination of the '184 patent.

**The request indicates that the Requestor considers the combination of either JP '022 or JP '401 and Promot 100 as raising a substantial new question of patentability for claims 6-8 of the '184 patent.**

It is agreed that the combination of JP '022 or JP '401 in view of Promot 100 raises an SNQ as to claims 6-8 of the '184 patent. The bottom of page 67 through the top of page 72 is hereby incorporated by reference for the explanation of the combination of teachings of JP '022 or JP '401 with Promot 100 regarding a two-shot molding process. While no date has been supplied for Promot 100, it is noted that

Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 9

during prosecution of the application which became the '184 patent, an IDS was submitted (6/16/1988) citing Promot 100 and noting that Figures 1 through 4 of Promot 11 illustrate the prior art described in the Background portion of the specification of the application which became the '184 patent. These combined teachings were not present in the prosecution of the application which became the '184 patent. Further, there is a substantial likelihood that a reasonable examiner would consider these teaching important in deciding whether or not these claims are patentable. Accordingly, the combination of JP '022 or JP '401 and Promot 100, raises a substantial new question of patentability as to claims 6-8, which question has not been decided in previous examination of the '184 patent.

**The request indicates that the Requestor considers the combination of either JP '227, JP '022 or JP '401 with either Blummer or Soreneson as raising a substantial new question of patentability for claim 9 of the '184 patent.**

It is agreed that the combination of either JP '227, JP '022 or JP '401 in view of either Bummer or Sorensen raises an SNQ as to claim 9 of the '184 patent. The bottom of page 72 through page 74 of the request is hereby incorporated by reference for the explanation of the combination of the teachings of any of JP '227, JP '022 or JP '401 and either Blummer or Sorensen regarding the securing of two mold components in a two-shot molding process. These combined teachings were not present in the prosecution of the application which became the '184 patent. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings

Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 10

important in deciding whether or not this claim is patentable. Accordingly, the combination of any of JP '227, JP '022 or JP '401 with either Blummer or Sorensen raises a substantial new question of patentability as to claim 9, which question has not been decided in previous examination of the '184 patent.

### ***Duty of Disclosure***

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 4,935,184 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

### ***Service of Papers***

After the filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.550(f).

### ***Waiver of Right to File Patent Owner Statement***

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement. The document needs to contain a

Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 11

statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester, see 37 C.F.R. 1.550(f).

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisanne Jastrzab whose telephone number is 571-272-1279. The examiner can normally be reached on Mon.-Thurs. 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Application/Control Number:  
90/008,976  
Art Unit: 3991

Page 12

**Notice Re Patent Owner's Correspondence Address**

Effective May 16, 2007, 37.CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)*

**The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.**

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Please mail any communications to:

Mail Stop *Ex Parte* Reexam  
ATTN: Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450

Application/Control Number:  
90/008,976  
Art Unit: 3991


Page 13

Alexandria, VA 22313-1450

Please FAX to:  
(571) 273-9900  
Central Reexamination Unit

Please hand-deliver to:  
Customer Service Window  
Randolph Building  
401 Dulany St.  
Alexandria, VA 22314

/Krisanne Jastrzab/  
Primary Examiner  
Central Reexamination Unit  
Art unit 3991  
(571) 272-1279

 /Alan Diamond/  
Primary Examiner  
Art Unit 3991  
JERRY D. JOHNSON  
PRIMARY EXAMINER  
CRU - AU 3991

**EXHIBIT C**

1  
2  
3  
4  
5  
6  
7  
8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA  
10

11 JENS ERIK SORENSEN, as Trustee of  
12 SORENSEN RESEARCH AND  
DEVELOPMENT TRUST,

13 Plaintiff,

14  
15 vs.  
16

17  
18  
19  
20 THE BLACK AND DECKER  
21 CORPORATION, et al.

22 Defendants.  
23  
24

CASE NO. 06cv1572 BTM (CAB)

ORDER:

(1) DENYING PLAINTIFF'S MOTION  
FOR RECONSIDERATION OF  
DENIAL OF OBJECTIONS TO  
MAGISTRATE JUDGE'S ORDER OF  
APRIL 9, 2007 AS MOOT [Doc.  
#163];

(2) GRANTING DEFENDANTS'  
MOTION FOR RECONSIDERATION  
OF THE COURT'S JUNE 20, 2007  
ORDER RE BIFURCATION [Doc.  
#171];

(3) GRANTING IN PART AND  
DENYING IN PART DEFENDANTS'  
MOTION TO STAY [Doc. #178];

and

(4) DENYING PLAINTIFF'S MOTION  
FOR PARTIAL SUMMARY  
JUDGMENT AS PREMATURE [Doc.  
#204]

25 **I. Motion for Reconsideration of Denial of Objections to Magistrate Judge's Order**

26 On April 9, 2007, Magistrate Judge Bencivengo issued an order in which she granted  
27 in part and denied in part Plaintiff's motion to compel further responses to discovery. In  
28 accordance with 28 U.S.C. § 636(b)(1)(A) and Fed. R. Civ. P. 72(a), Plaintiff filed an

1 objection to that ruling, arguing that it was both clearly erroneous and contrary to law. In an  
2 order entered June 14, 2007, the Court overruled Plaintiff's objection without prejudice. The  
3 Court found that the Magistrate Judge's determinations regarding the Black & Decker  
4 Defendants' waiver of the attorney-client privilege, and the applicability of Patent Local Rule  
5 2.5(d), were neither clearly erroneous nor contrary to law, on the record before the Court.  
6 However, the Court was unable to determine at that time whether, and to what extent, the  
7 Black & Decker Defendants ("B&D") intended to rely upon the death of Dennis Dearing to  
8 provide the requisite showing of prejudice in support of any laches and/or equitable estoppel  
9 defenses. Therefore, Plaintiff was granted leave to serve an interrogatory upon B&D, which  
10 stated: "Set forth, in detail, all prejudice to Defendants that resulted from the death of Dennis  
11 Dearing in regard to this case." To the extent Plaintiff believed that B&D's response to the  
12 interrogatory indicated that this Court's determination regarding waiver of the attorney-client  
13 privilege was in error, it was invited to move for reconsideration of the decision at that time.

14 On July 11, 2007, B&D responded to Plaintiff's interrogatory setting forth the prejudice  
15 that resulted from the death of its former in-house counsel Dennis Dearing. The prejudice  
16 identified included the inability to have Mr. Dearing testify regarding his communications in  
17 the mid-1990s pertaining to Mr. Jens Ole Sorensen's claims of infringement of the '184  
18 Patent. These communications included discussions directly with Mr. Sorensen and his  
19 representatives, as well as with John Schiech, Black & Decker's business manager  
20 responsible for making all decisions concerning the matter. B&D also indicated that it was  
21 prejudiced because it could not present Mr. Dearing as a witness to defend against Plaintiff's  
22 charge of willful infringement.

23 On July 12, 2007, Plaintiff filed the present motion to reconsider this Court's previous  
24 ruling on the basis of the new evidence presented in B&D's interrogatory response. The  
25 motion was calendared for hearing, without oral argument, on August 10, 2007. However,  
26 while the motion was pending, Magistrate Judge Bencivengo reconsidered her earlier ruling  
27 in light of B&D's interrogatory response. On August 3, 2007, Judge Bencivengo issued her  
28 "Order Following Discovery Conference on July 26, 2007" in which she ruled:

1 Since the defendant is affirmatively relying upon the death of Mr. Dearing to  
2 support its defense of laches, the plaintiff is entitled to review Mr. Dearing's  
3 files that still exist and reflect his personal thoughts and impressions, so  
4 plaintiff may respond to defendant's claim of lost evidence. Defendant was  
therefore ordered to produce any withheld documents reflecting Mr.  
Dearing's work product on this matter.

5 [Doc. #177 at ¶ 8.] Judge Bencivengo stayed production of Mr. Dearing's work product for  
6 30 days in order to give B&D an opportunity to appeal the order. B&D has just taken that  
7 opportunity and filed a motion for reconsideration on September 4, 2007 [Doc. #240]. B&D's  
8 motion is calendared for hearing by this Court on November 2, 2007.

9 In light of Judge Bencivengo's more recent order requiring production of Mr. Dearing's  
10 privileged documents, and the now-pending motion for reconsideration of that order, the  
11 Court finds moot Plaintiff's motion for reconsideration of its previous order overruling  
12 Plaintiff's objection to Judge Bencivengo's April 9, 2007 order. The Court finds that this  
13 entire issue will be addressed, upon a complete and updated record that includes Judge  
14 Bencivengo's August 3, 2007 order, in the Court's forthcoming decision on B&D's pending  
15 motion for reconsideration. Accordingly, Plaintiff's motion is **DENIED** without prejudice as  
16 moot.

17  
18 **II. Motion for Reconsideration of Bifurcation**

19 On June 13, 2007, the Court held a hearing on B&D's motion for summary judgment  
20 of laches. The Court denied B&D's motion at that hearing and discussion then ensued over  
21 the possibility of setting an expedited bench trial on B&D's equitable defenses of laches and  
22 estoppel. At B&D's urging, the Court and the parties agreed to schedule this bench trial  
23 beginning on December 17, 2007. In a June 20, 2007 written order confirming the Court's  
24 decision from the June 13 hearing, the Court explained that the trial of equitable defenses  
25 could be bifurcated from the rest of the trial proceedings relating to infringement. [Doc. #147  
26 at 2-3.] Citing the Ninth Circuit case of Danjaq LLC v. Sony Corp., 263 F.3d 942 (9th Cir.  
27 2001), the Court explained that, in deciding these equitable defenses, it would need to  
28 determine whether there has been any showing of willful infringement on the part of

1 Defendants that would act as a "counterdefense" to laches. The Court invited any party to  
2 make a motion for reconsideration of the decision to bifurcate the equitable portion of the trial  
3 if they felt that the Court's determination of the willfulness issue presented a problem for any  
4 subsequent jury trial proceedings.

5 On July 20, 2007, B&D accepted the Court's invitation and filed a motion for  
6 reconsideration of bifurcation. [Doc. #171.] B&D explained that it had not appreciated that  
7 the Court itself would need to make a finding on willfulness, without the aid of a jury, in any  
8 bifurcated trial on equitable defenses. In light of this realization, and its desire to retain its  
9 full rights to a jury determination on willfulness, B&D withdrew its request for an expedited  
10 bench trial on its equitable defenses.

11 Plaintiff has opposed B&D's motion for reconsideration arguing that there is no  
12 authority establishing any right to a jury trial on willfulness and, to the extent such a right  
13 exists, B&D has waived its rights by continually requesting that the Court schedule a short  
14 bench trial on laches before proceeding with the rest of the action.

15 The Court finds that the right to a jury trial on willfulness exists in a patent action that  
16 will be tried to a jury. See, e.g., Richardson v. Suzuki Motor Co., 886 F.2d 1226, 1250 (Fed.  
17 Cir. 1989). Having considered the submissions of the parties and the record of these  
18 proceedings, the Court does not find that B&D has knowingly waived its right to a jury trial  
19 on willfulness. Moreover, the early bifurcated trial on equitable defenses was scheduled by  
20 this Court in an effort to accommodate B&D's request for an early determination of laches,  
21 which it argued, if found, would greatly expedite the conclusion of this matter. Having  
22 recognized that a laches determination requires that this Court determine, before any jury  
23 has considered the question, whether Defendants willfully infringed Plaintiff's patent, B&D  
24 has withdrawn its request. The Court sees no reason to push ahead with a bifurcated trial  
25 despite B&D's express wishes.

26 The Court's recognition of the practical ramifications of the intertwinement of  
27 willfulness in any laches determination was the impetus for the Court's invitation to  
28 reconsider in its June 20, 2007 order. Having considered B&D's submission, which was

1 based upon the exact issues identified in this Court's own order, the Court hereby **GRANTS**  
2 B&D's motion. The bifurcated bench trial on equitable defenses previously scheduled for  
3 December 17, 2007 is hereby **VACATED**, along with all pretrial proceedings associated with  
4 it, including the November 26, 2007 pretrial conference.

5  
6 **III. Motion to Stay Litigation Pending Reexamination**

7 On August 3, 2007, all Defendants jointly filed a motion for a stay of these  
8 proceedings. Defendants' motion is based on B&D's pending request for reexamination of  
9 Plaintiff's '184 Patent, which was filed with the U.S. Patent and Trademark Office ("PTO") on  
10 July 30, 2007. The request for reexamination challenges, *inter alia*, all 5 claims of the '184  
11 Patent that are asserted in the present litigation. The challenge is based on a number of  
12 prior art references, almost all of which were apparently not considered by the PTO in the  
13 prosecution of the '184 Patent.

14 Courts have inherent power to stay an action pending conclusion of PTO  
15 reexamination proceedings. Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1426-27 (Fed. Cir. 1988).  
16 The decision whether to grant or deny a motion to stay proceedings pending PTO  
17 reexamination rests within the sound discretion of the court. See, e.g., Photoflex Products,  
18 Inc. v. Circa 3 LLC, No. C 04-03715 JSW, 2006 U.S. Dist. LEXIS 37743, at \*2-3 (N.D. Cal.  
19 May 24, 2006). There is a "liberal policy" in favor of granting motions to stay pending the  
20 outcome of PTO reexamination proceedings. ASCII Corp. v. STD Entertainment USA, Inc.,  
21 844 F. Supp. 1378, 1381 (N.D. Cal. 1994).

22 In determining whether to stay litigation pending reexamination by the PTO, courts  
23 generally consider the following factors: (1) the stage of litigation, i.e., whether discovery is  
24 almost complete and whether a trial date has been set; (2) whether a stay would cause  
25 undue prejudice or present a clear disadvantage to the non-moving party; and (3) whether  
26 a stay will simplify the issues in question and trial of the case. See, e.g., Xerox Corp. v.  
27 3Com Corp., 69 F. Supp. 2d 404, 406 (W.D.N.Y. 1999).

28 The Court finds that this litigation has not proceeded so far that it would be unjust to



1 stay the action. Although this action was originally filed about a year ago, and the Court  
2 recognizes that substantial amounts of discovery have already occurred, the more relevant  
3 inquiry is whether discovery is nearing completion – it is not.<sup>1</sup> For instance, Magistrate Judge  
4 Bencivengo recently granted the parties permission to take an additional 10 depositions per  
5 side. [See Doc. #159 at 2.] No deadline for the completion of fact discovery has even been  
6 set. Moreover, the parties are just beginning to brief the preliminary issue of claim  
7 construction and, in accordance with the decision above to vacate the bifurcated bench trial  
8 on equitable defenses, no trial date is currently set for any aspect of this case. In addition,  
9 while the Court has already considered two motions for summary judgment, it previously put  
10 off consideration of two others until after claim construction, and Plaintiff has just filed a  
11 substantial summary judgment motion aimed at piercing Black & Decker's corporate veil.  
12 The Court anticipates that further summary judgment motions regarding infringement and  
13 patent validity will be filed once claim construction is complete. Thus, a substantial amount  
14 of resources will be employed by all parties and the Court even in advance of any eventual  
15 trial. See, e.g., Broadcast Innovation, L.L.C. v. Charter Communications, Inc., No. 03-cv-  
16 2223-ABJ-BNB, 2006 U.S. Dist. LEXIS 46623, at \*26-31 (D. Colo. July 11, 2006) (granting  
17 stay, in part, because of significant work remaining on motions for summary judgement, even  
18 though trial date was less than three months away).

19 Plaintiff claims Defendants delayed filing their request for reexamination to gain a  
20 tactical advantage over it. He claims that Defendants were aware of the prior art that they  
21 reference in their reexamination request over seven months ago, but purposely delayed so  
22 that the '184 Patent would expire during the reexamination process, thereby precluding  
23 Plaintiff from offering any amendments to the claims. Defendants respond that there was no  
24 intentional delay and that their decision to request reexamination was based, in part, on the  
25 Supreme Court decision in KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007),  
26 which was only issued at the end of April. The Court is not convinced that Defendants

---

27  
28 <sup>1</sup> In reaching this determination, the Court has considered the surreply submitted by  
Plaintiff and, therefore, the pending ex parte request to file a surreply [Doc. #201] is  
**GRANTED.**

1 employed any improper tactics in filing their request for reexamination. While Plaintiff is  
2 rightfully concerned that a reexamination in the twilight of his patent puts him at a distinct  
3 disadvantage, he could have prevented this situation by filing suit many years ago, thereby  
4 allowing sufficient time for any reexamination to occur before the patent expired.

5 Therefore, Plaintiff's cognizable claims of prejudice if a stay should be entered  
6 basically boil down to his inconvenience in delaying final collection of any monetary award  
7 of royalties, assuming he ultimately wins. However, as the court recognized in Broadcast,  
8 the prejudice factor "is best summarized by one question: *do the Plaintiffs have an adequate*  
9 *remedy at law?*" 2006 U.S. Dist. LEXIS 46623, at \*32. Just as in Broadcast, the answer  
10 here is that clearly Plaintiff does have an adequate remedy. Defendants point out, and  
11 Plaintiff has not disputed, that the '184 Patent will expire in February 2008 independent of  
12 reexamination. Given that a trial on the merits could not occur prior to that date, Plaintiff  
13 would not have been granted any injunctive relief by this Court. Therefore, his claim would  
14 be restricted to past monetary damages, which, with the addition of prejudgment interest, are  
15 fully capable of compensating Plaintiff. Unfortunately, reexamination can be a drawn out  
16 process, resulting in a significant delay in court proceedings. Protracted delay is always a  
17 risk inherent in granting a stay, yet courts continue to stay actions pending reexamination.  
18 The general prejudice of having to wait for resolution is not a persuasive reason to deny the  
19 motion for stay. An average delay for reexamination of approximately 18-23 months is  
20 especially inconsequential where Plaintiff himself waited as many as twelve years before  
21 bringing the present litigation. (See PTO Reexamination Statistics at Ex. B to Niro Decl.;  
22 Doc. #180-3.)

23 In addition, the Federal Circuit has recently confirmed that the PTO would not be  
24 bound in its reexamination by the determinations of this Court. In re Trans Texas Holdings  
25 Corp., 2006-1599 and 2006-1600, 2007 U.S. App. LEXIS 19909, at \*14-19 (Fed. Cir. Aug.  
26 22, 2007). Because of this, the Court finds that not only is Plaintiff unlikely to be prejudiced  
27 in these proceedings by a stay pending the PTO reexamination, but Defendants would  
28 potentially be prejudiced by *failing* to enter a stay. One court has explained this possibility

1 accordingly:

2 Not only could the Court and the PTO reach conflicting determinations, but  
 3 one possible scenario could result in irreparable harm to [Defendant]: if this  
 4 Court finds that the [patent] is not invalid and that [Defendant] has infringed  
 5 it, and orders [Defendant] to pay damages to [Plaintiff] for such infringement,  
 then [Defendant] would have no ability to recover those damages if at a later  
 date the PTO determined that the [ ] patent is invalid.

6 Bausch & Lomb, Inc. v. Alcon Lab., Inc., 914 F. Supp. 951, 952 (W.D.N.Y. 1996). The Court  
 7 finds such a possibility to be, at a minimum, a highly undesirable outcome.

8 Finally, the Court finds that the stay will result in the simplification of issues in this  
 9 case. As explained by the Federal Circuit, "[o]ne purpose of the reexamination procedure  
 10 is to eliminate trial of [the issue of patent claim validity] (when the claim is canceled) or to  
 11 facilitate trial of that issue by providing the district court with the expert view of the PTO  
 12 (when a claim survives the reexamination proceeding)." Gould v. Control Laser Corp., 705  
 13 F.2d 1340, 1342 (Fed. Cir. 1983), cert. denied, 464 U.S. 935 (1983). The Broadcast court,  
 14 elaborating on this point, explained:

15 Shifting the patent validity issue to the PTO has many advantages, including:

16 1. All prior art presented to the Court will have been first considered by the  
 17 PTO, with its particular expertise.

18 2. Many discovery problems relating to prior art can be alleviated by the PTO  
 examination.

19 3. In those cases resulting in effective invalidity of the patent, the suit will  
 20 likely be dismissed.

21 4. The outcome of the reexamination may encourage a settlement without  
 the further use of the Court.

22 5. The record of reexamination would likely be entered at trial, thereby  
 23 reducing the complexity and length of the litigation.

24 6. Issues, defenses, and evidence will be more easily limited in final pretrial  
 conferences after a reexamination.

25 7. The cost will likely be reduced both for the parties and the Court.

26 2006 U.S. Dist. LEXIS 46623, at \*9-10 (quoting Emhart Indus., Inc. v. Sankyo Seiki Mfg. Co.,  
 27 3 U.S.P.Q.2d 1889, 1890 (N.D. Ill. 1987)).

28 The Court believes that it will benefit from the PTO's evaluation of how the previously

1 unconsidered prior art references impact the claims of the patent-in-suit. The PTO's expert  
2 evaluation is likely to be of assistance not only as to the issues of validity, but its  
3 understanding of the claims is also likely to aid this Court in the preliminary process of claim  
4 construction.

5 The Court finds that, especially in this case, the reexamination process has the  
6 potential to significantly narrow the issues for trial because of the impending expiration of the  
7 '184 Patent. While the parties have argued at length about exactly how this additional  
8 variable affects the calculation of the likely outcome of reexamination, the Court need not  
9 resolve this dispute to reach the proper conclusion. It is enough to note that when  
10 reexamination is requested by a third party, as in this case, all claims are confirmed only 29%  
11 of the time. (See PTO Reexamination Statistics at Ex. B to Niro Decl.; Doc. #180-3.) Since  
12 no amendments can be offered to an expired patent, there is obviously a significant likelihood  
13 that the validity of the claims at issue in this action will be affected by the reexamination  
14 process.<sup>2</sup>

15 In addition, the Court expects that the reexamination process will not only aid the  
16 Court in these proceedings, but should also redound to the benefit of the parties, both  
17 Defendants and Plaintiff. As the Broadcast court explained in its discussion of the possibility  
18 of prejudice from entering a stay:

19 If the PTO does not invalidate or otherwise alter the claims of the [] patent,  
20 the Plaintiffs' legal remedy remains unaffected . . . . Moreover, if the claims  
21 are narrowed, both sets of parties will have benefitted by avoiding the  
22 needless waste of resources before this Court, and again, the Plaintiffs will  
23 be able to pursue their claim for money damages at trial. Finally, if the claims  
24 are strengthened, the Plaintiffs' position will be as well, and their likelihood  
25 of monetary damages will increase. See, e.g., *Motson*, 2005 U.S. Dist.  
LEXIS, 2005 WL 3465664 at \*1 ("[I]f the PTO upholds the validity of plaintiff's  
26 patent, 'the plaintiff's rights will only be strengthened, as the challenger's  
27 burden of proof becomes more difficult to sustain.'") (quoting *Pegasus Dev.*  
28 *Corp.*, 2003 U.S. Dist. LEXIS 8052, 2003 WL 21105073 at \*2).

---

26 <sup>2</sup> Plaintiff has argued that the PTO is unlikely to grant reexamination precisely because  
27 the '184 Patent will expire soon. However, Plaintiff failed to produce any evidence to support  
28 this contention. Moreover, even if Plaintiff is correct, and the PTO fails to grant  
reexamination (a decision which should issue no later than October 30, 2007), this Court  
would immediately lift the stay and these proceedings would continue – a relatively  
insignificant 2-month delay being all that would result.

1 2006 U.S. Dist. LEXIS 46623, at \*32-33. Accordingly, the Court finds that a stay is  
2 appropriate to avoid the risk of unnecessary litigation and to permit the clarification of issues  
3 before this Court.

4 Therefore, Defendants' motion to stay this litigation is **GRANTED IN PART** and  
5 **DENIED IN PART**. With the exception of two pending motions, all proceedings are hereby  
6 stayed pending the PTO's reexamination of the '184 Patent. The Court will continue to hear  
7 Plaintiff's pending motion for entry of default against Defendant Porter-Cable Corporation  
8 [Doc. #182], which is calendared for hearing on October 12, 2007. As was discussed above  
9 in Section I, the Court will also continue to hear B&D's pending motion for reconsideration  
10 of Magistrate Judge Bencivengo's August 3, 2007 order regarding production of Dennis  
11 Dearing's attorney work product [Doc. #240], which is calendared for hearing on November  
12 2, 2007. The Clerk is directed to **VACATE** all scheduled discovery hearings, as well as the  
13 claim construction hearing previously set for November 19, 2007. All hearing dates will be  
14 reset, to the extent appropriate, once the stay of these proceedings has been lifted.

15 Defendants are ordered to file a notice informing the Court of the PTO's decision on  
16 the pending application for reexamination within 10 days of receipt of such decision. If the  
17 PTO declines B&D's request to reexamine the '184 Patent, the Court will immediately lift the  
18 stay and recalendar all vacated hearing dates. If, however, the PTO approves  
19 reexamination, this stay will remain in place pending some resolution of those proceedings.  
20 During the pendency of the reexamination, Defendants will be required to file a notice every  
21 6 months apprising the Court of any change in the status of those proceedings.

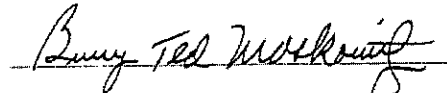
#### 22 23 **IV. Motion for Partial Summary Judgment**

24 On August 30, 2007, Plaintiff filed a motion for partial summary judgment piercing the  
25 corporate veils of the Black & Decker Defendants, or in the alternative, holding them to be  
26 a single enterprise for purposes of patent infringement liability. [Doc. #204.] The motion is  
27 presently calendared for hearing on October 26, 2007. In light of the Court's entry of a stay  
28 of these proceedings pending the PTO patent reexamination, the Court finds Plaintiff's

1 motion to be premature. Accordingly, the Court hereby **DENIES** Plaintiff's motion without  
2 prejudice.<sup>3</sup> As the Court is aware of the substantial volume of Plaintiff's motion, he is invited  
3 to refile this motion once the stay has been lifted by simply filing a short notice of motion  
4 which incorporates by reference his earlier filing.

5  
6 **IT IS SO ORDERED.**

7 DATED: September 10, 2007

8   
9  
10 Honorable Barry Ted Moskowitz  
United States District Judge

11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28 

---

<sup>3</sup> Plaintiff's pending motion to file confidential documents under seal in support of the motion for partial summary judgment [Doc. #204-5] is also **DENIED** as moot.

**EXHIBIT D**

1  
2  
3  
4  
5  
6  
7  
8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA  
10

11 JENS ERIK SORENSEN,

12 Plaintiff,

13 vs.

14 GIANT INTERNATIONAL (USA) LTD.,

15 Defendant.

CASE NO. 07CV2121 BTM (CAB)

ORDER GRANTING DEFENDANT'S  
MOTION FOR STAY PENDING  
PATENT REEXAMINATION

16 For the reasons stated in the Court's order granting stay in Sorensen v. Black and  
17 Decker, 06cv1572, Docket No. 243 and on the record at the February 25, 2008 status  
18 conference in Sorensen v. Helen of Troy, 06cv2278, the Court GRANTS without prejudice  
19 Defendant's motion for stay. The Court concludes that a reasonable stay is appropriate in  
20 this case because the litigation is in its early stages, Plaintiff has not established undue  
21 prejudice, and the reexamination will simplify issues for the Court and save expense for the  
22 parties. See, e.g., Xerox Corp. v. 3Com Corp., 69 F. Supp. 2d 404, 406 (W.D.N.Y. 1999).  
23 However, if it appears that the reexamination will not be effected within a reasonable time,  
24 Plaintiff may move to vacate the stay. Additionally, any party may apply to the Court for an  
25 exception to the stay if it has specific, valid reasons to believe that it needs to obtain  
26 discovery in order to preserve evidence that will otherwise be unavailable after the stay.

27 //

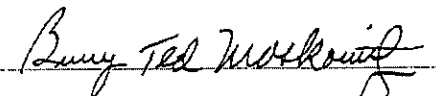
28 //



1 Defendant is ordered to file a notice informing the Court of the PTO's decision on the pending  
2 application for reexamination within 10 days of receipt of such decision.

3  
4  
5 IT IS SO ORDERED.

6  
7 DATED: February 28, 2008

8   
9 Honorable Barry Ted Moskowitz  
10 United States District Judge  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**EXHIBIT E**

1  
2  
3  
4  
5  
6  
7  
8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA  
10

11 JENS ERIK SORENSEN as Trustee of  
12 SORENSEN RESEARCH AND  
13 DEVELOPMENT TRUST,  
14  
15 Plaintiff,

CASE NO. 07CV2277 BTM (CAB)

ORDER GRANTING DEFENDANT'S  
MOTION TO STAY PENDING  
REEXAMINATION PROCEEDINGS

14 vs.

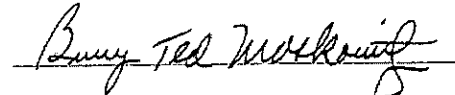
15 ESSEPLAST (USA) NC, INC. AND  
16 DOES 1-10,  
17 Defendant.

18 For the reasons stated in the Court's order granting stay in Sorensen v. Black and  
19 Decker, 06cv1572, Docket No. 243 and on the record at the February 25, 2008 status  
20 conference in Sorensen v. Helen of Troy, 06cv2278, the Court GRANTS without prejudice  
21 Defendant's motion for stay. The Court concludes that a reasonable stay is appropriate in  
22 this case because the litigation is in its early stages, Plaintiff has not established undue  
23 prejudice, and the reexamination will simplify issues for the Court and save expense for the  
24 parties. See, e.g., Xerox Corp. v. 3Com Corp., 69 F. Supp. 2d 404, 406 (W.D.N.Y. 1999).  
25 However, if it appears that the reexamination will not be effected within a reasonable time,  
26 Plaintiff may move to vacate the stay. Additionally, any party may apply to the Court for an  
27 exception to the stay if it has specific, valid reasons to believe that it needs to obtain  
28 discovery in order to preserve evidence that will otherwise be unavailable after the stay.

1 Defendant is ordered to file a notice informing the Court of the PTO's decision on the pending  
2 application for reexamination within 10 days of receipt of such decision.

3 IT IS SO ORDERED.

4  
5 DATED: March 19, 2008

6 

7 Honorable Barry Ted Moskowitz  
8 United States District Judge  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**EXHIBIT F**

1  
2  
3  
4  
5  
6  
7  
8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA  
10

11 JENS ERIK SORENSEN as Trustee of  
12 SORENSEN RESEARCH AND  
DEVELOPMENT TRUST,

13 Plaintiff,

14 vs.

15 ENERGIZER HOLDINGS INC.,  
EVEREADY BATTERY COMPANY, INC.  
and DOES 1-100,

16 Defendant.  
17

CASE NO. 07CV2321 BTM (CAB)

ORDER GRANTING DEFENDANT'S  
MOTION TO STAY PENDING  
REEXAMINATION PROCEEDINGS

18 For the reasons stated in the Court's order granting stay in Sorensen v. Black and  
19 Decker, 06cv1572, Docket No. 243 and on the record at the February 25, 2008 status  
20 conference in Sorensen v. Helen of Troy, 06cv2278, the Court GRANTS without prejudice  
21 Defendant's motion for stay. The Court concludes that a reasonable stay is appropriate in  
22 this case because the litigation is in its early stages, Plaintiff has not established undue  
23 prejudice, and the reexamination will simplify issues for the Court and save expense for the  
24 parties. See, e.g., Xerox Corp. v. 3Com Corp., 69 F. Supp. 2d 404, 406 (W.D.N.Y. 1999).  
25 However, if it appears that the reexamination will not be effected within a reasonable time,  
26 Plaintiff may move to vacate the stay. Additionally, any party may apply to the Court for an  
27 exception to the stay if it has specific, valid reasons to believe that it needs to obtain  
28 discovery in order to preserve evidence that will otherwise be unavailable after the stay.

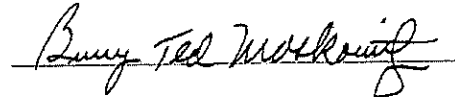
1 Defendant is ordered to file a notice informing the Court of the PTO's decision on the pending  
2 application for reexamination within 10 days of receipt of such decision.

3 IT IS SO ORDERED.

4

5 DATED: March 19, 2008

6



7

Honorable Barry Ted Moskowitz  
United States District Judge

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

**EXHIBIT G**



**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

JENS ERIK SORENSEN,

Plaintiff,

vs.

HELEN OF TROY and OXO  
INTERNATIONAL LTD.,

Defendant.

CASE NO. 07CV2278 BTM (CAB)

ORDER RE: (1) PLAINTIFF'S  
REQUEST FOR DEFAULT AND (2)  
DEFENDANT'S MOTION FOR STAY  
PENDING PATENT  
REEXAMINATION

For the reasons set forth on the record at the status conference held on February 25, 2008, the Court denies Plaintiff's request for entry of default and grants Defendants 60 days from the date of the status conference to file their answer on behalf of the correct entities served in this action. The Court orders the Clerk of the Court not to enter default pursuant to Plaintiff's request for entry of default. (Docket No. 20.)

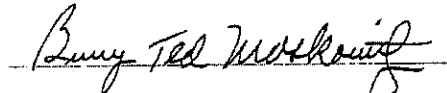
Also, for the reasons stated on the record and in the Court's order granting stay in Sorensen v. Black and Decker, 06cv1572, Docket No. 243, the Court also GRANTS without prejudice Defendant's motion for stay. The Court concludes that a reasonable stay is appropriate in this case because the litigation is in its early stages, Plaintiff has not established undue prejudice, and the reexamination will simplify issues for the Court and save expense for the parties. See, e.g., Xerox Corp. v. 3Com Corp., 69 F. Supp. 2d 404, 406 (W.D.N.Y. 1999). However, if it appears that the reexamination will not be effected within

1 a reasonable time, Plaintiff may move to vacate the stay. Additionally, any party may apply  
2 to the Court for an exception to the stay if it has specific, valid reasons to believe that it  
3 needs to obtain discovery in order to preserve evidence that will otherwise be unavailable  
4 after the stay. Defendant is ordered to file a notice informing the Court of the PTO's decision  
5 on the pending application for reexamination within 10 days of receipt of such decision.

6 Finally, during the status conference held on February 25, 2008, the Court discussed  
7 with the parties the option of transferring the various cases filed by Plaintiff regarding the '184  
8 patent and initiating a consolidated multi-district litigation proceeding. The parties informed  
9 the Court that they would consider the matter and inform the Court of its decision.

10 IT IS SO ORDERED.

11 DATED: February 28, 2008

12   
13 Honorable Barry Ted Moskowitz  
United States District Judge.